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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/442,152	11/16/1999	TOSHIHIRO SHIMA	04783.010001	5476
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ROSENTHAL & OSHA L.L.P. 1221 MCKINNEY AVENUE SUITE 2800 HOUSTON, TX 77010				
			EXAMINER WALLERSON, MARK E	
			ART UNIT 2626	PAPER NUMBER

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/442,152

Applicant(s)

SHIMA, TOSHIHIRO

Examiner

Mark E. Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on **11/17/2003**.

2. This application has been reconsidered. Claims 1-13 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubbels (U. S. 6,222,634) in view of Huttenlocher (U. S. 6,011,905).

With respect to claims 1, 6, and 10, Dubbels discloses a printer system (figure 5) comprising a first request means (210) which directly makes a first request for obtaining a resource from a server (610) (in the best mode of the Dubbels invention, the web page printer is integrated into the web browser) (column 7, lines 3-12); listing means (540) for determining a list of resources from the server (column 8, lines 1-38); setting means (540) for setting pages to be printed based on the structure of the determined source (column 7, lines 16-17); second request means (550) which makes a second request for obtaining structural data within the pages

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to be printed (column 6, lines 27-52 and column 7, lines 17-20); means (560) for generating print data based on the second response; and printing means (printer) for printing based on the generated data (column 2, lines 60-62, column 4, line 61 to column 5, line 5; and column 6, line 62 to column 8, line 64), wherein the first request means (210) the setting means (540), the second request means (550), the means for generating print data (560) and the printing means (560) are located on the printer (print mechanism).

Dubbels differs from claim 1, 6, and 10 in that he does not clearly disclose structure means for determining a structure of the resource. However, Dubbels teaches a list of web pages, generally written in HTML, which allows the user to select pages to print. A list of information resources in different formats (figure 7) such as GIF and JPG and links 740 and 750 allow a user to go to related web pages. When all the related links are passed and a list of related links is built, a display (800) results (figure 8) which include a list (810) of related links and a button (820) for the user to select pages to be printed (column 8, lines 1-38).

Huttenlocher teaches that HTML allows markup of the structure of the document (column 1, line 66 to column 2, line 20). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the teaching of Huttenlocher in Dubbels in order to use HTML to determine the structure of the documents.

With respect to claims 2, 3, 7, and 8, Dubbels does not clearly disclose judging the data format of the structural data and whether the structural data is printable data. However, Dubbels teaches that when web server (220) receives a web page request, it builds a web page in HTML and sends it to the requesting web browser (210). The web browser understands HTML and interprets it and outputs the web page to the monitor of the user workstation. Figure 7 depicts

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different formats that the web browser judges in order to convert them into printable data (column 8, lines 1-38). It would have been obvious to one of ordinary skill in the art at the time of the invention to have understood that the printing system includes judging means for judging the data format of the structural data since the web browser interprets the data in different formats and outputs the web page(s) to the monitor (column 2, lines 60-62; column 3, lines 13-18; column 4, line 61 to column 5, line 5 and column 8, lines 55-64).

With regard to claims 4, 5, 9, 11, and 12, Dubbels does not clearly disclose that the data format is moving picture data and the second request means obtains the structural data with the offset value from the top position of the resource. Huttenlocher discloses that HTML provides more flexibility than ASCII, in that it supports embedded graphics, images, audio and video recordings and hypertext linking capabilities (column 2, lines 2-5). Huttenlocher also discloses a structural document with an imaginary nonempty strip just above the top of the image which is used to compute the offset value (column 23, line 64 to column 24, line 7), therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Dubbels by the teaching of Huttenlocher in order to obtain a resource from the server and discriminate different formats and means for generating print data to be printed, wherein the resource is written in HTML (figure 10).

With regard to claim 13, Huttenlocher discloses that the structural means determines the page layout of the resource based on information relating to the size of data and information relating to the position of data and the setting means sets the pages to be printed in accordance with the determined page layout (column 1, lines 29-38; column 2, lines 2-32; column 22, line 36 to column 24, line 53 and column 26, line 15 to column 28, line 31).

Response to Arguments

5. Applicant's arguments filed 5/23/2003 have been fully considered but they are not persuasive.

Applicant submits that the first request means, the structural means, the setting means, the second request means, the means for generating print data and the printing means are located on the printer. The Examiner respectfully disagrees. The invention of Dubbels is described as "Apparatus and method for printing related web pages" (column 1, lines 7-8). Dubbels also discloses that his invention comprises a web client print **mechanism** 320 that is used to **print** individual web pages (emphasis added) (column 5, lines 26-28). Accordingly it is clear that the apparatus in Dubbels is either a printer or equivalent to a printer since it is being used for printing. Further, Dubbels discloses that, in the best mode of his invention, the web page print mechanism is integrated into the web browser thus providing a browser with advanced web page printing capability (column 7, lines 5-9). Dubbels also discloses the first request means (210) the setting means (540), the second request means (550), the means for generating print data (560) and the printing means (560) are located on the printer (print mechanism).

Conclusion

6. All claims are rejected.

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7. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

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(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview;
please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA.
Sixth Floor (Receptionist)

MARK WALLERSON
PRIMARY EXAMINER

Mark Wallerson